

## REMARKS

The last Office Action of July 27, 2007 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 54, 56-60, 66-71, 75 and 77-86 are pending in the application. No claims were cancelled. Claims 57, 60, 67, 75, 78, 80, 83 and 85 have been amended. A total of 23 claims is now on file including four independent claims. No claim surcharge is due.

Applicant hereby certifies that neither the international application nor the designation of the United States was withdrawn or considered to be withdrawn prior to the filing date of the U.S. national (35 U.S.C. 111(a)) application.

Applicant takes up the rejections in the order as set forth in the Office Action.

Claim 83 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 83 is also rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed had possession of the claimed invention.

It is further noted that claims 57, 78 and 79 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 60, 67 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 75, 80, 83 and 85 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 80 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 54, 56-60, 66, 68-71, 75, 77-84 and 86 are also rejected under 35 U.S.C. §112, first paragraph for lack of enabling disclosure.

#### **REJECTION OF CLAIM 83 UNDER 35 U.S.C. §112, SECOND PARAGRAPH**

Claim 83 was amended to add numerals for the steps and to delete "the". The scope of the claim has not been affected by this amendment. There were no claims dependent on claim 83.

Withdrawal of the rejection of claim 83 under 35 U.S.C. §112, second paragraph is thus respectfully requested.

#### **REJECTION OF CLAIM 83 UNDER 35 U.S.C. §112, FIRST PARAGRAPH**

Claim 83 was amended to change "suitable" to —solid—to avoid the rejection.

Withdrawal of the rejection of claim 83 under 35 U.S.C. §112, first paragraph is thus respectfully requested.

#### **REJECTION OF CLAIMS 54, 56, 60, 66-71, 77-86 UNDER 35 U.S.C. §112, SECOND PARAGRAPH**

Claim 57 and 78 were amended to change "the range to —a range—. Claim 79 refers to claim 78 and therefore refers properly to "the range".

Withdrawal of the rejection of claims 57 and 78 under 35 U.S.C. §112, second paragraph is thus respectfully requested.

With respect to claim 60, applicant notes there is only one type of linking reaction as set forth in the claim. The claim is clear on this. Therefore, applicant has changed "the start of the linking reaction" to — start of the linking reaction—. As the claim states, linking takes place at the specified temperature, so it does not matter where linking takes place. By the way, claim 75, from which claim 60

depends is silent to a first layer or second layer and there is only one type of covalent linking claimed.

With respect to claim 67, the Markush grouping has been fixed so that the wording complies with the rules.

With respect to claims 75, 80, 83 and 85, the Examiner has stated that "the covalent linking" has not antecedent basis in these claims. Applicant deleted the definite article "the" to avoid the rejections. Claim 83 does not refer to this limitation. The correction to claim 80 has been discussed *supra*.

Based on the foregoing, the rejections are believed to have been obviated.

Withdrawal of the rejection of claims under 35 U.S.C. §112, second paragraph and allowance thereof are thus respectfully requested.

#### **REJECTION OF CLAIMS 54, 56-60, 66, 68-71, 75, 77-84 AND 86 UNDER 35 U.S.C. §112, FIRST PARAGRAPH**

The Examiner based his rejection on "non-enablement" and "undue experimentation to practice the claimed invention without the magnetic/triboelectric particles.

Applicant traverses the rejection. The Examiner cites the Examples in which "magnetic" appears. However, applicant cannot be held just to the examples since these are the best mode examples. On page 11 of the specification, it is stated that "magnetic" represents a preferred mode.

It is well established that the specification is not required to teach every detail of the invention or to be a production specification. It is only necessary to draft the specification in such a manner that a person skilled in the art is able to make and use the invention, without requiring an inordinate amount of experimentation. Here the specification by inference also includes the one component toner. In this connection, reference is made to the decision *In re Geerdes*, 180 USPQ 789 (CCPA, 1974) which discussed the question of "undue experimentation". In *Geerdes*, the invention involved was a method of producing expanded or foamed polymer compositions without using standard blowing agents. The method milled particles of a polymer together with submicron

particles of an additive material having advantageous properties. The Examiner rejected, and the Board affirmed a rejection of the claims and the specification under Section 112, first paragraph, i.a. that the invention was not enabling because experimentation would be required to determine proportions and particle sizes. On appeal, the CCPA reversed. As pointed out by the Court, the fact that some experimentation may be required is not determinative of the enablement requirement under Section 112, first paragraph. Thus, Geerdes instructs that a patent application is enabled even if some experimentation is required to make and use the invention.

In the case at hand, a person skilled in the art at or prior to 1998 knew or was knowledgeable about one component toners and would be able to make and use the invention, even though the specification lacks a working example. However, Section 112, first paragraph does not require or mandate that a specific example be disclosed so long the specification is disclosed in such manner as to enable a person skilled in the art to practice the invention without undue experimentation. *In re Borkowski*, 164 USPQ at 645. It is applicant's belief that the instant specification satisfies the requirement under section 112, first paragraph.

It is applicant's contention that the claimed invention has been adequately disclosed.

Based on the above discussion, it is believed that the rejection is unwarranted.

Withdrawal of the rejection of claims 54, 56-60, 66, 68-71, 75, 77-84 and 86 under 35 U.S.C. §112, first paragraph is thus respectfully requested.

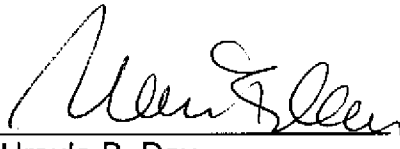
### **CONCLUSION**

In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

Reconsideration and allowance of the present application are respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

Respectfully submitted,

By:   
Ursula B. Day  
Attorney For Applicant  
Reg. No: 47,296

Date: November 27, 2007  
350 Fifth Avenue  
Suite 4714  
New York, N.Y. 10118  
(212)244-5500  
UBD:af